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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,722	03/27/2001	Eric Flam	FLAM 2A	1331

7590

02/10/2006

Henry I. Schanzer, Esq.  
29 Brookfall Road  
Edison, NJ 08817

EXAMINER
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BROWN, MICHAEL A

ART UNIT	PAPER NUMBER
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3764

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

6

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/818,722		FLAM ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Michael Brown		3764	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7, 11-36, 38-77 and 79-90 is/are pending in the application.
- 4a) Of the above claim(s) 41-66 and 83-86 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21 and 22 is/are allowed.
- 6) ☒ Claim(s) 1-7, 11-20, 23-26, 38-40, 67-77, 79-82 and 87-90 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

Note: This office action was made final because claims 3 and 31 were rejected improperly in the last office action.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 4-5 13-20, 23, 28, 40, 67-72, 75-77, 79-82 and 87-90 are rejected under 35 U.S.C. 102(b) as being anticipated by Engelman.

Engelman discloses in figures 5-6 a leg elevator that anticipates a prosthesis comprising a protective device (or referred to as a protective structure) 17, a hard outer shell 10. The pad is made of a soft material (foam), the pad is made in a semicircular shape and a means S1-S3 for securing. The pad extends beneath the foot and heel (fig. 6). The protective structure is shaped to be placed between a body part and a supporting surface. The (pad) protective device is fabricated of a firmness. The pad is fabricated of a material that enables tissue growth (foam) and dissolves over time. Engelman discloses a cut-out in the device. The cut-out is the opening between the side.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 and 4-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Mercer.

Mercer discloses in figures 1-5 a cast that anticipates a prosthesis comprising a protective device 18, a rigid outer shell 14 and a rigid inner shell 16.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Engelman in view of Vazquez

Engelman discloses in figures 5-6 a leg elevator that anticipates a prosthesis, substantially as claimed. However, Engelman doesn't disclose a mesh material. Vazquez teaches in figures 1-2 a limb support comprising a mesh material (col. 4, lines 20-23). It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the mesh material disclosed by Vazquez could be incorporated into the device disclosed by Engelman in order to use the mesh material to allow the device to breathe.

Claims 6, 11-12, 24-30 33-36 and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engelman.

Engelman discloses in figures 5-6 a prosthesis, device, substantially as claimed. However, Engelman doesn't disclose the pad having a thickness of one fourth of an inch, a length one quarter of an inch and a width one quarter of an inch. It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the thickness of the pad disclosed by Engelman could be one fourth of an inch and the width and the length could be one quarter of an inch because the dimension is not critical and it doesn't provide novelty over the prior art. The width and length of the pad being between one quarter and six inches is a design choice.

Claims 27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engelman.

Engelman discloses in figures 5-6 a leg elevator that anticipates a prosthesis, substantially as claimed. However, Engelman does not disclose the protective device being a rectangular shaped. It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the protective device disclosed by Engleman could be rectangular shape because it is a design choice as to how the protective device is shaped. The protective device could also be oblong in shape.

Claims 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engelman in view of Swartz, along with Barth.

Engelman discloses in figures 5-6 a leg elevator, that anticipates a prosthesis, substantially as claimed. However, Engelman does not disclose a layer between the user's skin and the outer surface of the pad. Swartz teaches in figure 2 a protective

device comprising a layer 14 that is located between a layer 16 and the outer skin of the user's foot. Barth teaches in figure 1 a pad that can be used to support the ankle, wherein the pad has a dressing 5 thereon. It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the layer that is between the user's skin and the lower layer as taught by Swartz could be incorporated into Engelman in order to have a layer that is breathable to allow air to pass through the layer. The dressing could be used to absorb bodily fluids and to protect the ankle from chafing.

Claims 73-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engelman in view of Suzuki.

Engelman discloses in figures 5-6 a leg elevator, that anticipates a prosthesis, substantially as claimed. However, Engleman does not disclose the pad including a fatty substance. Suzuki teaches in figure 1 a protective device comprising a fatty substance that includes a tatty substance that includes silicone (col. 6, lines 29-31). It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the fatty substance including the silicone as taught by Suzuki could be incorporated into the device disclosed by Engleman in order to use the silicone to prevent fluids from being absorbed into the protection device.

***Allowable Subject Matter***

Claims 21-22 are allowed.

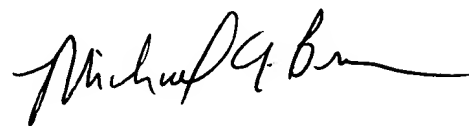
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Brown whose telephone number is 571-272-4972. The examiner can normally be reached on 5:30 am-4:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gergory Huson can be reached on 571-272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Brown  
February 6, 2006

A handwritten signature in black ink, appearing to read "Michael A. Brown", with a long horizontal flourish extending to the right.

MICHAEL A. BROWN  
PRIMARY EXAMINER